

### **REMARKS**

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested. Claim 1 is amended without prejudice or disclaimer.

#### **Response to Arguments**

Prior to discussing the amendments and responses to below, Applicants provide comments on the Office Action's response to our previous arguments. The Office Action's basic position to Applicants' arguments is that it would not have been obvious to modify the teachings of Slezak with Chen et al. because "the Office Action does not indicate the combination of the system or the teachings of Slezak with the system of Chen." Applicants respectfully submit that this is a distinction without a difference. In fact, on page 3 of the Office Action just a few lines following the above quoted statement, the Office Action concludes that it would be obvious to one of skill in the art "to combine elements as taught by Chen and elements as taught by Slezak with Sezan's system...." In other words, the resulting "combination" includes the teachings of Chen et al., Slezak and Sezan et al. Applicants submit that it is clear that the resulting system is a combination of elements from each reference. If the element from Chen et al. is element "A" and the element from Slezak is "B" and the teachings of Sezan et al.'s system are "C" then the resulting system equals  $A + B + C$ . Applicants' argument is that one of skill in the art would not likely combine A and B. Applicants submit that it is unpersuasive when the Office Action asserts that it is not combining the teachings of Slezak with the teachings of Chen et al. when the practical and common sense result is clearly the combination of such teachings.

Applicants further note that the analysis of page 3 uses the language "yield predictable results" citing the language of KSR International, Co. v. Teleflex Inc., 550 US \_\_\_\_ (2007). Applicants shall provide arguments based on the KSR decision to correct the analysis in the Office Action. The KSR Court required on page 13 that the question is whether the

improvement is more than the predictable use of prior art elements according to their established functions. Furthermore, on page 14, the Court noted that the Examiner should provide an explicit analysis to “determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” Also in this section, the Court notes that the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, “where a Court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”

The fundamental issue in KSR was much more simple than the present case. For example, page 21 notes that for a designer starting with Asano, the question was where to attach the sensor. The consequential legal question is then “whether a pedal designer of ordinary skill starting with Asano would have found it obvious to put the sensor in a fixed pivot point.” The Court goes on to provide an analysis that there were a number of prior art teachings that placed sensors in various locations and thus leading the Court to the conclusion that attaching the sensor where both KSR and Ingelgau put it would have been obvious to a person of ordinary skill. The fundamental conclusion of KSR is not that the TSM approach is overturned but that it should not be applied strictly to exclude the findings as to the specific understandings or principles within the skilled artisan’s knowledge that would motivate one with no knowledge of the invention to take such steps as to attaching an electronic control to the Asano assembly support bracket.

Even in the syllabus of the KSR decision Section 1(b), the Court noted that the TSM test captures a helpful insight, namely, that “a patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the art.” There still must be an identifiable reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does. Applicants respectfully submit that the response to arguments falls into this category. Namely, page 3 of the Office Action simply

states that all of the elements as claimed are known in Sezan et al., Chen et al. and Slezak. There is no analysis regarding what would have prompted a person of ordinary skill in the art to combine the elements as the new invention does in the response to arguments. Therefore, Applicants submit that all that has occurred is that the several elements have been demonstrated as independently known in the art. This, however, does not prove that the composed several elements are obvious to one of skill in the art.

Applicants have noted and set forth above that there are reasons why one of skill in the art would have been unlikely to combine these references. Furthermore, Applicants note that the issue raised in KSR was quite simple. As is noted above, the basic question for one of skill in the art was whether a pedal designer of ordinary skill starting with Asano would have found it obvious to put the sensor on a fixed pivot point. The basic question was where to place a sensor. If such a question were to be posed in the present case, it would be much more complicated. The invention of claim 1 involves numerous steps dealing with a coded video sequence. The legal question in this case might be posed as whether a person of ordinary skill in the art of coding video sequences and customizing video sequences may have found it obvious to extract image data from a plurality of still images, derive virtual camera scripts and coding hints from the image data (and based on our amendments above, wherein the derived camera scripts comprises a generated sequence of frames that simulates camera movement), generate a video sequence based on the extracted image data and the derived virtual camera scripts and coding hints, output the coded video sequence while at the same time insert a customized advertisement during the multi-media presentation wherein the inserted customized advertisement includes an offer of an award to a user contingent at least partly on the user interaction with the customized advertisement. As can be easily seen, the legal question in the present case is much more complicated than the simply positioning of a sensor starting with the Asano pedal as is the case

in KSR. The ultimate analysis of KSR can be summed up in a simple sentence. There were prior art references that included different ways of attaching sensors. A pedal designer needed to identify where to attach a sensor. Using the known prior art, it would have been obvious to that person to attach the sensor at a fixed pivot point on a pedal. The analysis in the present case is not so simple. Applicants have laid out multiple reasons why several of the teachings of the references would be unlikely to combine. Applicants' arguments apply even in the analysis in the response to arguments. One of skill in the art would be unlikely to take elements from Chen et al. and separate elements from Slezak and then insert those into the Sezan system. This is for the reasons set forth above and in our previous amendment.

Applicants also address the concept of yielding a predictable result. In KSR, the predictable result was quite simple. Namely, it would be predictable that positioning a sensor at a fixed pivot point would work according to these sensors' established function. Therefore, the analysis works for KSR. In the present case, Applicants note that there would have to be modifications from the established functions of the teachings of Slezak or Chen et al. Applicants have set out the conceptual changes or modifications that would have to be made from the established functions as is taught in these references. Therefore, the issue discussed on page 13 of KSR with regards to whether the improvement is more than the predictable use of prior art elements according to their established functions or is not easily applied here. Applicants submit that the present case differs from KSR in its complexity as well as on the issue that more is required than simply upgrading a pedal with the sensor according to the known and established functions of the sensor. This is because the elements of Chen et al. and the elements of Slezak cannot be simply incorporated based on their established functions as those functions are defined and discussed in the references. The references focus on a different use and different processes. Therefore, blending all of these references together into one combination of elements in the

present case is not the equivalent of an improvement that is comprised of the predictable use of prior art elements according to their established functions. Therefore, Applicants submit that we have made a more detailed and appropriate analysis of the combination of these references in view of recent Supreme Court precedent rather than making merely conclusory statements. Accordingly, Applicants maintain their argument that it would not be obvious to combine these references in the manner performed in the Office Action. More discussion on this issue is provided below.

However, to facilitate prosecution of the present case, Applicants have amended claim 1 as is suggested above and such amendment shall be addressed below.

**Rejection of Claims 1-8 and 10-28 Under 35 U.S.C. §103(a)**

The Office Action rejects claims 1-8 and 10-28 under 35 U.S.C. §103(a) as being unpatentable over Sezan et al. (U.S. Patent No. 6,236,395) ("Sezan et al.") in view of Chen et al. (U.S. Patent No. 6,307,550) ("Chen et al.") and further in view of Slezak (U.S. Patent No. 6,006,257) ("Slezak"). Applicants traverse this rejection but as noted above, have amended claim 1 in order to distinguish the present invention.

Claim 1 is amended to recite deriving virtual camera scripts and coding hints from the image data includes wherein the derived virtual camera script comprises a generated sequence of frames that simulates camera movement. The Office Action asserts that Sezan et al. teach the concept of deriving virtual camera scripts in column 4, line 40 – column 5, line 35. Applicants note that the two components discussed here are the program views and the program profiles. Applicants submit that a careful review of both the program description scheme which comprises two sets of information, the program views and program profiles, do not encompass the recited concept of a virtual camera script that comprises the generated sequence of frames that simulates camera movement. In other words, the discussion of program views in column 4, lines 43-59

and the separate discussion of camera profiles found in column 4, line 59 – column 5, line 9, and the further discussion in column 5, lines 10-25, do not teach a virtual camera script that comprises any generated sequence of frames. They merely provide an analysis of the existing frames or characteristics of the content of the programs such as the actors, stars, rating, director and so on. Therefore, Applicants submit that this feature is not taught or suggested in the reference.

Page 5 of the Office Action states that Chen et al. discloses deriving virtual camera scripts in column 2, lines 1-55. Applicants traverse this analysis and note that here they teach obtaining still images from already video. In other words, they are not generating a new image but rather are pulling or retrieving from a video a still image. For example, if there is a pan shot, then multiple video frames from the existing video are stitched together to create a high resolution panoramic image. Therefore, Applicants submit that there is no “virtual camera script” of the type that is recited in claim 1. Furthermore, Chen et al. is cited in column 5, lines 6-30 as also teaching this feature. This portion discusses virtual reality players in which they are associated with a still image which simply enables a user to pan about a panoramic image or zoom into an image. Therefore, Applicants submit that when this is carefully viewed it does not teach the derived virtual camera scripts of the type recited in claim 1.

Next, Applicants also further discuss the KSR case with additional comments on the analysis in the Office Action beyond the response to arguments. Applicants again note that in KSR that the legal question was whether a pedal designer of ordinary skill starting with Asano would have found it obvious to put the sensor in a fixed pivot point. Applicants shall step through the complicated analysis that is required in order to combine these references and shall explain why multiple steps are required.

Page 5 of the Office Action concludes the analysis of Sezan and adds the statement regarding the teachings of Chen et al. in which Chen et al. is taught as disclosing multimedia input from a subscriber and deriving virtual camera scripts from the image data. Applicants note that they actually fail to teach the amended version of deriving virtual camera scripts as set forth above. However, the conclusion in the Office Action with regards to the “apparent reason” to combine the known elements is that it would have been obvious of one of ordinary skill at the time the invention was made to modify Sezan et al. to use the teachings as taught by Chen et al. in order to provide multimedia input from subscribers to an output device thereby improving efficiency in the multimedia data generating. Applicants question this analysis for the primary reason that Sezan et al. already provide “multimedia input from a subscriber to an output device.”

Figure 2 of Sezan et al., feature 38, provides the multimedia input as well as making reference to data and services such as internet services or DTV data services which could be from a subscriber. In other words, simple multimedia input already existed in Sezan et al. It would be as though the Asano reference in KSR already taught a sensor at the pivot.

Applicants note that KSR also requires that to facilitate the view, the analysis must be made explicit. In other words, Applicants respectfully submit that the Examiner cannot rely on the analysis on page 5 to combine Chen et al. with Sezan et al. The analysis is simply redundant of the teachings of Sezan et al. in which there is already provided multimedia input from a subscriber to an output device as is shown in Figure 2. Therefore, Applicants submit that this certainly differs from KSR in which the Asano reference did not have any teaching with regards to a sensor or the location of a sensor and the artisan would have to look elsewhere to other prior art references to seek guidance on design and choices. In this present case, the analysis is

unconvincing because the teachings of Chen et al. are certainly not needed for the concept of providing multimedia input.

Next, the apparent reason to combine the known elements in the fashion claimed is articulated on page 5 is for the purpose of “proving efficiency in multi-media data generating.” This is used for the purpose of combining Chen et al. with Sezan et al. However, later, the Office Action changes the apparent reason to combine when Slezak is cited and on page 7 concludes that it would be obvious to modify Sezan et al. in view of Chen et al. to use the teachings as taught by Slezak in order to “improve efficiency and advertising.” Applicants note a very generic trend of simply citing “efficiency” as the apparent reason to combine these elements. Applicants respectfully submit that the analysis is lacking and the Applicants have provided a more detailed analysis for regards to the actual teachings and “inferences and creative steps” that a person of ordinary skill in the art would draw from and employ if these references were viewed by one of ordinary skill. See KSR, page 14. Applicants further note from the KSR decision that the fact finder must still be aware of distortion caused by hindsight bias and must be cautious of arguments relying upon expost reasoning. Applicants submit that in the present case, by merely resorting to “efficiency” and multiple different reasons to cobble together these different references, Applicants submit that the present case is much more complicated than what was analyzed in KSR. Even though the TSM structure is not to be applied rigidly to deny facts for finders recourse to common sense, Applicants submit that a more common sense analysis with respect to the differing teachings of the cited references leads to a conclusion that one of ordinary skill in the art would not be simply making design choices as occurred in the KSR decision. Therefore, Applicants provide these further arguments setting forth why one of skill in the art would be unlikely to combine these references.




Nevertheless, Applicants note that they have amended claim 1 and submit that even if combined these references fail to teach each limitation of the claims. Therefore, claim 1 and 2-8 and 10-28 are patentable and in condition for allowance.

**CONCLUSION**

Having addressed all rejections and objections, Applicants respectfully submit that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited. If necessary, the Commissioner for Patents is authorized to charge or credit the **Law Office of Thomas M. Isaacson, LLC, Account No. 50-2960** for any deficiency or overpayment.

Respectfully submitted,

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By:  \_\_\_\_\_

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